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10/082,774

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Gregory P. Fitzpatrick

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EXAMINER

BRINEY III, WALTER F

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/082,774	Applicant(s) FITZPATRICK ET AL.	
	Examiner WALTER F. BRINEY III	Art Unit 2615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-11,13-19 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-11,13-19 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

5 (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10 **1. Claims 1, 3-11, 13-19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,263,064 (filed 29 January 1999) (“O’Neal”) in view of US Patent 6,631,186 B1 (filed 21 November 2000) (“Adams”) in view of US Patent 6,697,473 B2 (filed 13 November 2001) (“Batten”) and further in view of US Patent 5,436,963 (filed 19 January 1995) (“Fitzpatrick”).**

15 **Claim 1** is limited to a method of message delivery. This claim includes nine steps. The preamble of this claim requires that the method is for facilitating message delivery and conferencing within a communications system having multiple communications channels using multiple media types. *O’Neal* discloses a system for facilitating message delivery since, for example, it allows a caller to execute a follow-me
20 service to track down a called party. *O’Neal* at col. 12 ll. 5-9. *O’Neal* further discloses multiple media types, such as phone calls, pages and emails. *Id.* at col. 14 ll. 18-33, fig.4 (depicting message alerts, such as voicemail and email and a paging option). Simply facilitating conferencing is such a broad statement that it amounts to no positive claim limitation. Moreover, none of the other claim limitations are related to a conferencing
25 function. Without positive method steps recited in the preamble nor connection between

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the claim body's method steps and the preamble, the facilitating of conferencing appears to be a mere statement of intended use afforded no patentable weight. *See Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999); *see also Rowe v. Dror*, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir.

5 1997) ("where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation").

Concerning the first step, this step includes six separate features. Concerning the first feature of the first step, this claim requires registering with the communications
10 system a plurality of reception states established by a receiving party. O'Neal provides a control center seen in figs.3 & 4 for registering a plurality of reception states. For example, at time T₁ the user of the O'Neal system registers his status using the dashboard 302 of fig.3 and the further options of fig.4; at later time T₂, the same user updates their status and options. *See id.* at col. 11 ll. 37-50.

15 Concerning the second feature of the first step, this claim requires that the reception states specify reception state data. The individual options set in the dashboard of figs.3 & 4 correspond to this claimed reception state data. *Id.* at col. 11 ll. 51-58.

Concerning the third feature of the first step, this claim requires that the reception state data comprises a plurality of rules for establishing a communications link with one
20 or more receiving party addresses. The individual options set in the dashboard of figs.3 & 4 also correspond to the claimed rules since they include options like "Follow Me," "Paging," "Call Forward" and "Alternate Number" that facilitate connection between a

caller and the user/subscriber of the dashboard. *Id.* at col. 11 ll. 51-58, col. 12 ll. 1-17, ll. 58-67, col. 13 ll. 1-7, ll. 61-67, col. 14 ll. 1-17.

Concerning the fourth feature of the first step, this claim requires that the rules define one or more categories of messages based on i) a nature of each message, ii) a time
5 at which the receiving party prefers to receive delivery of the messages in each of the categories, iii) a communication channel through which the receiving party prefers to receive delivery of the messages in each of the categories and iv) a receiving party address associated with the communication channel at which the receiving party prefers to receive delivery of the messages in each of the categories. The sixth feature of the first
10 step requires that the nature of each message is determined taking into consideration criteria including a purpose of the message and an identity of the sending party. *O'Neal* discloses the third and fourth elements of the claimed categories. Specifically, *O'Neal* discloses options allowing a subscriber to indicate to which communication channel messages are routed, such as a telephone channel, pager channel or email channel. *Id.* at
15 col. 11 ll. 51-58, col. 13 ll. 18-39. Further, a subscriber provides an address so the message can actually be delivered to the subscriber over either a telephone channel, pager channel or email channel. *Id.* *O'Neal*, however, fails to fully disclose the categories as claimed since *O'Neal* does not disclose categories based on the nature of a message (i.e. purpose of the call and identity of the sending party) or the time at which the receiving
20 party prefers to receiver delivery of messages. However, this is overcome by an obvious modification in view of the teachings of *Adams*, *Batten* and *Fitzpatrick*.

Regarding the “nature of each message”, *Adams* teaches a “System and Method for Implementing and Accessing Call Forwarding Services.” In general, a subscriber is enabled to control their call forwarding system in accordance with updated personal settings. One such setting is a priority screening list. *Adams* at col. 6 l. 49 to col. 7 l. 9.

5 The priority screening list contains numbers of caller numbers that will not be forwarded to a subscriber’s registered forwarding telephone number. *Id.* While neither *O’Neal* nor *Adams* discusses the advantages of call screening, the name given by *Adams* alone describes its utility. Specifically, priority screening means that only a caller of certain “high” priority will be able to contact a subscriber away from their primary number.

10 Such an arrangement prevents telemarketers or other nuisance callers from disturbing a subscriber through forwarding from their primary number. It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate provisions for caller number identification as taught by *Adams* for the purpose of reducing the volume of forwarded telephone numbers, which also results in a reduction of disturbance to a
15 user from unsolicited or nuisance calls. This combination of *O’Neal* and *Adams* results in a priority screening list so that the communication options provided by *O’Neal* are applied selectively to particular sending parties based on their identities.

Adams combined with *O’Neal* still does not fully determine the nature of a call, since the combination does not take into account the purpose of the call. However,
20 *Batten* teaches an automated personalized telephone management system that handles calls based not only on caller identifications but also based on whether a call is an emergency or not. *Batten* at col. 3 ll. 38-54. Whether a call is an emergency or not is a

determination of the calls purpose since an emergency call is made as a call for immediate action by the called party, whereas non-emergency calls comprise other species of purpose not requiring immediate action. *Batten* teaches that identifying emergency calls allows emergency calls to pass caller identification screening so that emergency calls are not missed. *Id.* Receiving an emergency call is clearly advantageous over not receiving an emergency call since the delay arising from missing the call might result in missing the opportunity for remedial action against the cause for emergency. It would have been obvious to one of ordinary skill in the art at the time of the invention to screen calls based on caller identification and whether the call is an emergency for the purpose of receiving all emergency calls regardless of whether the emergency caller's number is not registered as a number allowed to access call forwarding assistance ala *Adams*.

Regarding "time at which the receiving party prefers to receive delivery of the messages in each of the categories", it is noted that *O'Neal* requires a user to log in to the unified messaging system web site in step 602 of fig.6 every time the user wishes to modify a communication option in step 612. This requirement is recognized as problematic by *Fitzpatrick*. *Fitzpatrick* at col. 1 ll. 29-39. In solution, *Fitzpatrick* provides an electronic calendar to enable automatic routing of incoming calls. *Id.* at col. 1 ll. 40-60. Figs.2a & 2b of *Fitzpatrick* illustrate a method of routing an incoming call: a caller is presented with calendar information from a calendar database in steps 210-290, a number associated with the callee's calendar schedule is retrieved for connection in steps 300-410 and a connection is established in steps 420-450. It would have been obvious to

one of ordinary skill in the art at the time of the invention to modify the unified messaging system of *O'Neal* with the teachings of *Fitzpatrick* for the purpose of eliminating the constant reprogramming required of O'Neal's system. For example, the system of *O'Neal* provides follow me service with a primary and secondary list that can
5 be selectively placed into operation through subscriber reprogramming. *O'Neal* at col. 12 ll. 50-57. *Fitzpatrick* teaches using a calendar to automatically switch between these follow me lists so the need for subscriber reprogramming is eliminated.

Concerning the fifth feature of the first step, this claim requires that in at least one reception state the defined communication channel is different from a communication
10 channel associated with a first communication link initiated by a sending party. *O'Neal* discloses options allowing a subscriber to indicate which communication channel messages are routed, such as a telephone channel, pager channel or email channel. *Id.* at col. 11 ll. 51-58, col. 13 ll. 18-39. So a telephone call may be routed to a pager. *Id.*

Concerning the second step, this claim requires initiating the first communications
15 link by a sending party. *O'Neal* discloses receiving at the call center a calling party's call at step 502, which call inherently requires an initiation over a first communication link. *O'Neal* at fig.5.

Concerning the third step, this claim requires identifying a receiving party address from the first initiated communications link. Likewise, *O'Neal* identifies a receiving
20 party address from an initiated communication link. *Id.* at col. 15 ll. 14-30, fig.5 steps 502, 504.

Concerning the fourth step, this claim requires retrieving reception state data specified by said plurality of reception states according to said receiving party address. *O'Neal* similarly discloses retrieving stored communication options. *Id.* at col. 15 ll. 31-43, fig.5 step 506.

5 Concerning the fifth step, this claim requires classifying said first initiated communications link into one of said categories. Based on the foregoing combination of *O'Neal, Adams, Batten* and *Fitzpatrick* a call is categorized by comparing a caller's identification against priority list; determining whether a call is an emergency; comparing the time of the call against times in a calendar; and then deciding to route the call to a
10 subscriber address on a telephone channel, paging channel or email channel.

 Concerning the sixth step, this claim requires a) presenting said portion of said reception state data associated with said one of said categories to the sending party via the communication channel associated with the first initiated communications link, b) wherein said reception state data is presented in a form compatible with a device of the
15 sending party making the first initiating communications link, c) wherein said reception state data is presented according to a context of the communication. On-demand services, such as Follow Me and Paging, each comprising a "communication channel" and "a receiving party address...at which the receiving party prefers to receive delivery of said message in each of said categories," are indicated to the user along with calendar
20 information, which corresponds to "a time at which the receiving party prefers to receive delivery of said messages in each of said categories" as taught by *Fitzpatrick*. *O'Neal* at col. 12 ll. 18-49; *Fitzpatrick* at col. 3 ll. 13-35. Note that *Fitzpatrick* teaches that the

information is presented in speech format. *Fitzpatrick* at col. 3 ll. 13-35. In this way, the prior art combination performs “presenting said portion of said reception state data associated with said one of said categories to the sending party via the communication channel associated with the first initiated communications link, wherein said reception
5 state data is presented in a form compatible with a device of the sending party.”

Furthermore, according to the teachings of *Adams*, only users on a priority screening list are provided information, such that the foregoing combination of prior art presents reception state data according to a context of the communication (i.e. the identity of the caller).

10 Concerning the seventh step, this claim requires interpreting the received reception state data by the sending party. The caller informing the *O’Neal* system of the caller’s demand to contact the called party is the manifestation of an interpretation of an instruction asking whether the caller wishes to contact the called party through the follow-me service.

15 Concerning the eighth step, this claim requires instructing the communications system how to process said first initiated communications link by the sending party. The caller’s indicated demand itself is clearly an instruction to the *O’Neal* system on how to process the initial communication link established in step 502, since the demand indicates whether to execute the follow-me service.

20 Concerning the ninth step, this claim requires processing said first initiated communications link based on the instructions from the sending party. In *O’Neal*, subsequent execution of the follow-me service corresponds to the processing said first

initiated communications link based on the instruction from the sending party since the execution handles the caller's call from step 502 based on the caller's demand just like the processing processes the first initiated communications link based on the instruction from the sending party. Therefore, *O'Neal* in view of *Adams* in view of *Batten* and
5 further in view of *Fitzpatrick* makes obvious all limitations of the claim.

Claim 3 is limited to the method of claim 1. *O'Neal* simply does not disclose "identifying a sending party address and determining contextually relevant reception state data according to said identified sending party address and said receiving party address." However, this deficiency is overcome by an obvious modification.

10 Adams teaches a system and method for implementing and accessing call forwarding services. See Abstract. In general, a subscriber is enabled to control their call forwarding system in accordance with updated personal settings. One such setting is a priority screening list. See column 6, line 49 through column 7, line 9. The priority screening list contains numbers of caller numbers that will not be forwarded to a
15 subscriber's registered forwarding telephone number. While neither *O'Neal* nor *Adams* discusses the advantages of call screening, the name given by *Adams* alone describes its utility. Specifically, priority screening means that only a caller of certain "high" priority will be able to contact a subscriber away from their primary number. Such an arrangement prevents telemarketers or other nuisance callers from disturbing a subscriber
20 through forwarding from their primary number, in fact, some prior art systems that implement embodiments similar to the system of *Adams* are referred to as nuisance call blockers/screeners. It would have been obvious to one of ordinary skill in the art at the

time of the invention to incorporate provisions for caller number identification as taught by Adams for the purpose of reducing the volume of forwarded telephone numbers, which also results in a reduction of disturbance to a user from unsolicited or nuisance calls.

5 **Claim 4** is limited to the method of claim 3. The data presented to the caller of *O'Neal* is inherently based on the type of channel used, as it makes little sense to perform call forwarding in response to a page or email, and the time a communications link is opened as a subscriber can change his/her options anytime.

Claim 5 is limited to the method of claim 1. It is understood by one of ordinary
10 skill in the art from the disclosure of *O'Neal* that if a dialed subscriber in *O'Neal* picks up after being dialed “said first communications link will be completed.”

Claim 6 is limited in part to the method of claim 1. It is understood by one of ordinary skill in the art from the disclosure of *O'Neal* that if the calling party in *O'Neal* hangs up before or after a call completion, “said first communications link will be
15 terminated.”

Claim 7 is limited to the method of claim 6. *O'Neal* discloses call forwarding and follow me service, which enable “initiating a second communications link to a different receiving party address using the same communications channel as said first initiated communication link” where the first link is a telephone call and the caller
20 chooses to try and contact the receiving party. See column 12, lines 30-49.

Claim 8 is limited the method of claim 6. *O'Neal* discloses sending pages or message alerts, which enable “initiating a second communications link using a

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communications channel different from the communications channel of said first initiated communications link.” For example, a caller can send a page. See column 13, line 61, through column 14, line 10.

Claim 9 is limited to the method of claim 1. *O’Neal* clearly provides the ability
5 to handle multiple occurrences of a calling party dialing a subscriber to the unified messaging system, such that *O’Neal* discloses “detecting at least one additional initiated communications link from subsequent sending parties; and presenting said reception state data to selected ones of said subsequent sending parties.”

Claim 10 is limited to the method of claim 1. As stated in claim 9, the system of
10 *O’Neal* doesn’t block a receiving party or sending party from connecting with a third party at some other time and presenting reception state data thereto. If a third party calls a subscriber, the third party will receive reception state data.

Claims 11 and 15-19 are each directed toward a machine-readable storage with a program that executes method that are essentially the same as those recited in claims 1,
15 and 5-9. The system disclosed by *O’Neal* is computerized. See figure 2 and column 7, line 12, through column 9, line 67.

Claims 13 and 14 are each directed toward a machine-readable storage with a program that executes method that are essentially the same as those recited in claims 3 and 4. The system disclosed by *O’Neal* is computerized. See figure 2 and column 7, line
20 12, through column 9, line 67.

Claim 21 is limited to the method of claim 1. This claim requires the additional step of gathering reception state data from a receiving device using an agent. *O’Neal*

discloses a communication dashboard 302 that serves as a virtual agent for collection of reception state data. *O'Neal* at col. 11 ll. 36-50, figs.3 & 4.

Response to Arguments

Applicant's arguments have been fully considered but they are not persuasive.

5 Applicant alleges that it would not be reasonable to assume that the *Batten* system could be combined with *O'Neal* without an explanation of how to do so. (Applicant Arguments 11-12, 28 April 2008). In other words, Applicant is arguing that one of ordinary skill in the art would not know how to combine *Batten* and *O'Neal*, or that the combination is not enabled. Without more, this allegation is unpersuasive; one of ordinary skill in the art
10 need only program the system of *O'Neal* to execute the program flow seen in figs.2-5 of *Batten*.

Applicant further alleges that the call exception process of *Batten* does not cover all the cases of identity and purpose covered by the present invention, including distinguishing between different types of emergency situations. (Applicant Arguments
15 12, 28 April 2008). However, the claims broadly require discerning a purpose of the message, not distinguishing a list of specific emergency situations. Applicant also alleges that *Batten* does not teach handling alternate channels or multiple party conferencing using multiple media types. (Applicant Arguments 12, 28 April 2008). However, *Batten* was not cited to reject these limitations.

20 Applicant alleges that the present invention allows a caller to ultimately decide how to route a call, such that the caller can ring a subscriber's phone no matter what (i.e. against the reception state data registered in the first step of claim 1) while *O'Neal* does

not allow this feature. (Applicant Arguments 13, 28 April 2008). Although *O'Neal* may not teach such a feature, that feature is also not claimed. Instead, claim 1 only requires in the eighth and ninth steps, instructing the communications system how to process the first initiated communications link by the sending party and processing the first initiated communications link based on the instructions from the sending party. These two steps do not require the ability for the caller to instruct the communication system in a manner contrary to the reception state data registered in the first step of claim 1.

Applicant alleges that *Batten* could not be used to manage instant messaging. (Applicant Arguments 14, 28 April 2008). Regardless of the truth of this statement, instant messaging is not a claim limitation.

Applicant further lists limitations that the cited prior art allegedly does not disclose, teach or suggest. (Applicant Arguments 14-16, 28 April 2008). However, Applicant may not simply state that the claims define over the prior art without particularly pointing out a difference. Accordingly, these allegations are unpersuasive.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than
5 SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to WALTER F. BRINEY III whose telephone number is (571)272-7513. The examiner can normally be reached on M-F 8am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's
10 supervisor, Suhan Ni can be reached on (571) 272-7505. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status
15 information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call
20 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Walter F. Briney III/
Examiner
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